



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/483,831	01/17/00	STRACKE	M 2026-4149US4

HM12/0816  
Office Of Technology Transfer  
National Institutes Of Health  
Box Ott  
Bethesda MD 20892

EXAMINER

ROBINSON, P

ART UNIT	PAPER NUMBER
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1653

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DATE MAILED:

08/16/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/483,831

Applicant(s)

STRACKE ET AL.

Examiner

Patricia A. Robinson

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1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2025 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-25 is/are rejected. *claims 20-25 rejected by 112 - why only 21-25?*
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

The preliminary amendment filed 1/17/2000 has been received and entered. Claims 1-19 have been cancelled as requested and new claims 20-25 have been added.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20 and 25 and all dependent claims thereto are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites "wherein said polypeptide thereof has cell motility activity", it is not clear whether the polypeptide has motility or whether the polypeptide has the ability to regulate the motility of something else and if so what is the something that is being moved absent a structure which is defined by the amino acid sequence. The claim as written is ambiguous, unclear, confusing and therefore indefinite.

Claim 21 is indefinite since where claim 20 does not define the structure it is not apparent whether or not cell motility activity is retained by the claimed but undefined fragment.

Claim 22 is indefinite since it is not apparent how cell motility is retained when the protein is bound to a solid support.

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Claim 23 is indefinite in regard to "substantially pure form" because the specification does not define the requisite parameters (percentage, does it include or exclude glycosylation, etc.) of what constitutes "substantially pure". Thus, it is not apparent how "substantially pure form" would differ from "pure form" or "essentially pure."

Claim 25 recites "a recombinant autotaxin", but it is not clear what properties an autotaxin protein must possess in order to qualify as "recombinant". Thus, the claim as written is unclear, confusing and, therefore indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Stracke et al.

Stracke et al. teaches the isolated polypeptide for human autotaxin and fragments thereof. (See Abstract and pages 2525-2526). Stracke et al. also teaches the polypeptide bound to a solid support. (See page 2525 and page 2526, Fig. 10 and column two). Moreover, Stracke et al. teaches a purification method comprising the steps of collecting and concentrating supernatant from cultured A2058 human melanoma cells, that is salt fractionated and further purified by column chromatography.

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(See pages 2527-2728). Furthermore, where claim 25 does not differentiate recombinant from non-recombinant, the reference discloses the claimed autotaxin.

***Conclusion***

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following prior art contains parallel information and applicability to the claimed invention: Murata et al. and Stracke et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A. Robinson whose telephone number is 703-305-0096. The examiner can normally be reached on 8:00 - 4:30 Monday - Friday, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 703-308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

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PAR

August 14, 2000

*Christopher S. F. Low*  
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